

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:)	Attorney Docket No. 56490.000004
)	
David VERCHERE)	Confirmation No. 9529
)	
Serial Number: 09/838,133)	TC/A.U.: 3625
)	Examiner: Yogesh C. Garg
Filed: April 20, 2001)	
)	Customer No. 21967

For: METHOD AND SYSTEM FOR CONFIGURING PRODUCTS

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This is Appellant's Reply Brief responsive to the Examiner's Answer mailed May 4, 2006, in connection with the above-captioned patent application. Appellant presents this brief to clarify points raised by the Examiner in the Examiner's Answer.

Appellant believes that there is no fee required for the submission of this Reply Brief. However, the Commissioner is hereby authorized to charge Deposit Account No. 50-0206, if deemed necessary.

Appellant appreciates the withdrawal of the rejections under 35 U.S.C. §§ 101 and 112. Specifically, the rejections of claims 1-5, 7-15 and 17-20 under 35 U.S.C. § 101 have been withdrawn in view of *Ex parte Lundgren*, 76 U.S.P.Q.2d 1385 (Bd. Pat. App. & Int. 2006). In

addition, the rejection of claims 1-5, 7-15 and 17-20 under 35 U.S.C. § 112, first paragraph have been withdrawn in view of Appellant's persuasive arguments. See page 4, Examiner's Answer.

I. The Examiner's Has Failed to Show Each and Every Claim Limitation in a Single Reference

Claims 1-5, 7, 9-15, 17 and 19-20 are allegedly anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,493,677 B1 to von Rosen *et al* (hereinafter "Rosen"). The Examiner states that "Rosen teaches the use of a pricing algorithm which generates a combination price of the item and associated processes" by relying on Figures 8A, 8B, 9A, 9B, and 10. See page 7, Examiner's Answer. The "pricing" feature of Rosen relied upon by the Examiner is a basic traditional price quote, as shown in Figure 9B and 11B. The static price quote of Rosen fails to meet the claimed limitations directed to "*separating the product into at least an item, a process and an artwork wherein one or more item parameters, one or more process parameters and one or more artwork parameters are identified;*" "*applying a pricing algorithm for assigning a price to the product wherein the price is based on the item, the process and the artwork where a combination of the item parameters, process parameters and artwork parameters generates the price;*" and "*linking the item parameters, the process parameters and the artwork parameters;*" and "*creating a product identifier for the product.*" Rather, the Examiner summarily concludes that "[a]s regards the step, (ii) 'applying a pricing algorithm ... generates the price,' Rosen suggests this." See page 9, Examiner's Answer. Whether Rosen makes any such *suggestion* does not rise to the level of anticipation. Rather, the Examiner has conveniently ignored positively recited limitations to reach his conclusion of anticipation.

The Examiner indicates that “the features upon which applicant relies (i.e., if a customer modifies the various parameters it will result in a corresponding modified price ...) are not recited in the rejected claim(s).” *See* page 9, Examiner Answer. The context of the statement questioned by the Examiner is an illustrative example taken from the specification to demonstrate the clear differences from the disclosure of Rosen and the claimed invention. As Rosen merely discloses a static price, the illustrative embodiment supported by the claimed invention is not feasible within the system and method of Rosen.

Under 35 U.S.C. § 102, anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. In addition, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. *In re Donohue*, 766 F.2d 531, 533, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). In this case, the Office Action has failed to show that Rosen discloses each and every claim limitation recited by Applicants. It is noted that the Examiner has not relied on any allegations of inherency, as there is no record of any rational or evidence tending to show inherency.

II. The Examiner’s Proposed Combinations are Fundamentally Flawed

Claims 8 and 18 are allegedly unpatentable under 35 U.S.C. § 103(a) by Rosen *et al* in view of Official Notice. With regards to Official Notice, as the Examiner has provided several references to allegedly show that the concept of quantity break pricing information as process parameters is well known, the Examiner’s arguments concerning Appellant’s traversal are now moot. *See* page 14, Examiner’s Answer. However, the statement that applicant “has demanded for an evidence/affidavit to substantiate the Official Notice for the first time in the Appeal Brief”

is simply untrue. *See* page 12, Examiner's Answer. In fact, Appellant timely traversed the Official Notice in response to the Office Action mailed April 28, 2004. In response, the Examiner refused to provide documentary evidence in the Final Office Action mailed October 13, 2004. Therefore, the next instance for Appellant to again request evidentiary support was in the Appeal Brief. However, none of the newly cited references show that quantity break pricing information is well known and old in the art, within the context of branded promotional products. This is a feature that the Examiner has yet to find a teaching reference.

The Examiner merely concludes that "a quantity price break will motivate the buyer to purchase more in quantity, as he saves money, and at the same time will benefit the seller for accruing increased revenue and also profits. *See* page 14, Office Action mailed October 13, 2005. Controlling Federal Circuit and Board precedent require that the Office Action set forth specific and particularized motivation for one of ordinary skill in the art to modify a primary reference to achieve a claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) ("[t]o prevent a hindsight-based obviousness analysis, [the Federal Circuit has] clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references.").

When a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz*, 234 F.3d at 664. In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the

teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention. Because such a proper motivation to combine is missing, the proposed modification is improper and the rejections should be overturned.

If the approach taken by this Examiner were adopted, in almost every instance, some reason for a modifying a reference could be created by the Examiner unrelated to any actual problem recognized in the art. It is the requirement that the motivation to solve a recognized problem be from the teachings of the art that keeps the application process honest to the goal of avoiding hindsight reconstruction. Indeed, the very key aspect in determining obviousness should be that there is a clear nexus between the teachings in the art as to the deficiencies in a particular way of doing things and a solution provided by the supplemental references. In addition, even if the references could be modified as proposed by the Examiner, the resulting modification would nevertheless fail to render the claim inventions obvious.

III. The Examiner Has Failed To Meet The Burden Of Proof

Under U.S. law, an inventor is entitled to a patent for any invention that is new, useful, and non-obvious. 35 U.S.C. §§ 101-103. The applied reference fails to teach each and every limitation and therefore fails to establish a *prima facie* case of anticipation. In addition, the Examiner's Answer has not presented a *prima facie* case of obviousness by which to deny a patent to Appellants. The Examiner summarily concludes that the claim limitations are met without ever explaining why one of ordinary skill in the art would (1) modify the applied reference and (2) how the resulting modification meets the claimed inventions. Even if the references could be combined as suggested by the Examiner, the resulting combination would nevertheless fail to teach the combination of claim limitations recited by Appellants.

CONCLUSION

For at least the foregoing reasons, the rejections of claims 1-5, 7-15 and 17-20 should be reversed.

Respectfully submitted,

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